

REMARKS

Claims 1-29 were pending and presented for examination and in this application. In an Office Action dated September 11, 2007, claims 1-29 were rejected. Applicants thank the Examiner for examination of the claims pending in this application and address the Examiner's comments below.

Applicants are amending claims 2 and 19 in this Amendment and Response. In view of the Amendments herein and the Remarks that follow, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

Response to Rejection Under 35 USC §112, Paragraph 2

In the Office Action, the Examiner has rejected claims 2 and 19 under 35 USC §112, ¶ 2 as allegedly not specifically pointing out and distinctly claiming the subject matter that the Applicants regard as the invention.

Applicants have amended claims 2 and 19 to recite "wherein the periodic requests are directed to an identified closed port at a remote network node." This amendment has been made to provide sufficient antecedent basis for the limitation in the claim. The basis for this rejection has now been obviated and withdrawal of the rejection is requested.

Response to Rejection Under 35 USC §103(a) in View of Vanlint and Gibart

In the Office Action, the Examiner rejects claims 1-29 under 35 USC §103(a) as allegedly being unpatentable over U.S. Patent No. 6,922,417 ("Vanlint") in view of U.S. Patent Publication No. 2004/0153534 ("Gibart"). This rejection is respectfully traversed.

1. Vanlint

Applicants respectfully submit that use of the Vanlint reference is improper as a basis of a section 103 rejection. The Vanlint reference is a reference commonly owned by the assignee of the present application at the time the claimed invention was made. The Vanlint reference at most qualifies as prior art under 102(e) since it was published after the present application was filed, but has a filing date before the filing date of the present application. The Vanlint reference is not prior art under 102 (a), (b), (c) or (d). Moreover, if the Vanlint reference is not considered prior art for section 103, a prima facie case of obviousness would not be established, and the claimed invention would be patentably distinct over the art of record.

In view of 35 USC § 103(c), Applicants respectfully submit that the Vanlint reference cannot be used to preclude patentability of the claimed invention because per that section:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis added)

Here, the application for the claimed invention was filed on July 24, 2003, before the issue date of Vanlint of July 26, 2005. Therefore, Vanlint at best is citable art under 35 USC § 102(e). The Vanlint reference was assigned to Compuware Corporation, in an assignment recorded April 26, 2001 and recorded with the U.S. Patent Office at Reel 011754, Frame 0087. A copy of the assignment history for the Vanlint reference is attached as Exhibit A for the Examiner's reference. The present application with the claimed invention was assigned to the same Compuware Corporation, in an assignment recorded on July 24,

2003 at Reel 014323, Frame 0903. A copy of this assignment is attached as Exhibit B for the Examiner's reference. The title to both the Vanlint reference and the present application currently remain assigned to Compuware Corporation.

Thus, the subject matter of the Vanlint reference and the present application with the claimed invention were, at the time the present application with the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Under 35 USC § 103(c) the subject matter of Vanlint cannot preclude patentability of the claimed invention.

2. Gibart

Applicants respectfully submit that Gibart does not qualify as prior art under 102(e). In support of this conclusion, Applicants submit a Declaration under 37 CFR § 1.131 of William Noble, a representative of Compuware Corporation, the assignee of the present invention to establish documentary proof that the invention described and claimed in the Application was conceived prior to January 31, 2003, the U.S filing date of Gibart. Additionally, Applicants respectfully submit a Declaration under 37 CFR § 1.131 of Stuart Meyer, the supervising attorney who oversaw the preparation of the present application by Devin Morgan, to establish documentary proof that diligence was present from prior to the effective date of Gibart, January 31, 2003 to the date of constructive reduction to practice, July 24, 2003.

Cited reference Gibart has a U.S. filing date of January 31, 2003. However, as set forth in William Noble's Declaration, Applicant's invention was conceived in the United

States prior to the effective filing date. In addition, as noted in the Declaration of Stuart Meyer, the present invention was diligently reduced to practice leading up to the filing date of July 24, 2003. In view of these declarations, it is respectfully submitted that the basis for the rejection to claims 1-29 is improper and should be withdrawn.

With Gibart unavailable as prior art, the claimed invention is patentably distinct over the remaining reference. As the Examiner correctly observes, Vanlint alone fails to disclose, teach or suggest “a single active agent configured to transmit requests and receive responses to the requests to generate a single trace file.” Vanlint discloses monitoring traffic on two nodes of a network and merging the trace files to give latency data on opposite sides of the network. (See, e.g., Vanlint, Abstract). In contrast, the claimed invention uses a single network node that uses a single trace file to calculate latency to a remote node and back. Hence, Applicants respectfully request consideration and withdrawal of the rejection and allowance of the pending claims.

Based on the above the remarks, Applicants respectfully submit that for at least these reasons claims 1-29 are patentably distinguishable over the cited references. Therefore, Applicants respectfully request that the Examiner reconsider the rejection, and withdraw it.

Conclusion

In sum, Applicants respectfully submit that claims 1-29, as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,
JOSEPH V. RUSTAD ET AL

Date: November 12, 2007

By: /Stuart P. Meyer/

Stuart Meyer, Attorney of Record
Registration No. 33, 426
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Phone: (650) 335-7286
Fax: (650) 938-5200